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| <b>Office Action Summary</b> | <b>Application No.</b><br>10/780,743 | <b>Applicant(s)</b><br>YANAMI ET AL. |  |
|                              | <b>Examiner</b><br>P. Kathryn Wright | <b>Art Unit</b><br>1797              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9,10,13,15,16 and 19-22 is/are pending in the application.  
     4a) Of the above claim(s) 19-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9,10,13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                                  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2009 has been entered.

### ***Status of the Claims***

2. This action is in response to papers filed October 30, 2009 in which claims 9-10, 13, 15-16, and 19 were amended and claims 20-22 were added. The amendments have been thoroughly reviewed and entered.

Any objection/ rejection not repeated herein have been withdrawn by the Examiner.

Claims 9-10, 13-16 and 19-22 are pending.

### ***Election/Restrictions***

3. Newly submitted claims 20-22 are directed to an invention that is distinct from the invention originally claimed for the following reasons: the automatic analyzer in claim 9 requires a rail and a controller for controlling the sample probes to reciprocally move between the sample suction position and the sample discharge position alternately so as to prevent the sample probes from colliding with each other, and a sample in a sample container positioned at the sample suction position being discharged into a reaction cuvette that is moved and positioned at the sample discharge position using

the plurality of sample probes. These limitations are not required in claim 20. Furthermore, new claim 20 requires a nozzle clogging detecting means for detecting a clogging of a nozzle of the sample dispensing mechanism. This limitation is not required in claim 9. Restriction for examination purposes is proper because all these inventions listed in this action are distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because the inventions require a different field of search (for example, employing different search queries), the prior art applicable to one invention would not likely be applicable to another invention, and the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “analyzing means” is not supported in the original disclosure, however an optical detector is disclosed throughout Applicant’s specification, see for example pages 14 and 17.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 9-10, 13, 15-16 and 19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an optical detector, does not reasonably provide enablement for the broader limitation of an analyzing means. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. See for example pages 14 and 17 of Applicant's original disclosure. The scope of the claims is not commensurate with the scope of the enabling disclosure.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 9-10, 13, 15-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Buhler et al., (US Patent No. 5,762,872), hereinafter Buhler.

Buhler teaches an automatic analyzer comprising:

analyzing means 9, 11 for analyzing a sample;

a plurality of sample probes (12, 14), each sample probe including a sample probe head having a sample nozzle for dispensing a sample;

two x-axis rails and two y-axis, the sample probes being mounted to move along the rails (see Figs. 1-2);

the sample probes moving along the rails from a sample suction position 13 to a sample discharge position in a reaction cuvette 3;

a plurality of reaction cuvettes 3 into which samples are dispensed by the sample probes and in which a reaction takes place followed by analysis with the analyzing means; and

a controller (not shown but necessary) for controlling the sample probes to reciprocally move between the sample suction position and the sample discharge position alternately so as to prevent the sample probes from colliding with each other as the x-axis rails approach each other, a sample in a sample container positioned at the sample suction position being discharged into a reaction cuvette that is moved and positioned at the sample discharge position using the plurality of sample probes,

wherein the rails make a closed loop in a rectangular shape as seen from the top in Fig. 2 including the sample suction position and the sample discharge position;

each of the sample probes having a moving path, moving paths of the sample probes being different from each other, each of the sample probes being moved between the sample suction position and the sample discharge position, and

a plurality of washing ports 19 for washing the sample probes, each of the washing ports being arranged at each of the moving paths.

As to claims 10 and 16, Buhler teaches wherein the closed loop has substantially an rectangular shape looking from above the sample probe.

With respect to claims 13 and 19, Buhler teaches the controller can operate the probes independently. Thus, it is expected that one of the probes can be stopped while the other probe continues to operate.

Regarding claim 15, Buhler teaches an analyzing method for an automatic analyzer comprising the steps of:

dispensing samples from a plurality of sample probes, each sample probe including a sample probe head having a sample nozzle for dispensing a sample;

mounting the sample probes to move along the rails from a position for suction of a sample to a sample discharge position;

it is expected a controller controls the sample probes to move reciprocally between the sample suction position and the sample discharge position alternately so as to prevent the sample probes from colliding with each other, a sample in a sample container positioned at the sample suction position being discharged into one of plurality of reaction cuvettes, in which a reaction is to take place that is moved and positioned at the sample dispensing position using the plurality of sample probes, and

analyzing samples discharged into the reaction cuvettes with a detector; and

wherein the movement of the sample probes makes a closed loop including the sample suction position and the sample discharge position;

each of the sample probes having a moving path, moving paths of the sample probes being different from each other, each of the sample probes being moved between the sample suction position and the sample discharging position, and

a plurality of washing ports 19 for washing the sample probes, each of the washing ports being arranged at each of the moving paths (see entire document, in particular col. 2, line 3 et seq.)

***Response to Arguments***

9. Applicant's arguments with respect to claims 9-10, 13, 15-16 and 19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. No claims allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. Kathryn Wright/  
Primary Examiner, Art Unit 1797